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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,618	02/19/2002	J. Barry Shackleford	100110018-1	5631

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HEWLETT-PACKARD COMPANY
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EXAMINER

MANIWANG, JOSEPH R

ART UNIT PAPER NUMBER

2144

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,618

Applicant(s)

SHACKLEFORD, J. BARRY

Examiner

Joseph R. Maniwang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/05/05

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 10/05/05 was in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement was considered.

Claim Rejections - 35 USC § 102

1. Claims 1-3, 5-7, 10-14, 18-20, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Fleming, III et al. (U.S. Pat. No. 6,625,444), hereinafter referred to as Fleming.
2. Regarding claims 1, 6, 10-12, 18-19, 25, and 26, Fleming disclosed a method and system comprising generating an electronic mail message in response to data entered by a user, the electronic mail message including user-selected preference data for the electronic system (see column 4, lines 17-34; column 4, line 60 through column 5, line 2); transmitting the electronic mail message to an electronic mail destination (see column 4, lines 17-34; column 4, line 60 through column 5, line 2); automatically extracting the user-selected preference data from the message (see column 5, lines 2-5); transmitting the user-selected preference data to an electronic system (see column

4, lines 32-49); and configuring the electronic system with the user-selected preference data (see column 4, lines 32-49). Fleming disclosed the use of a cellular phone (see column 2, lines 54-64), thus disclosing the use of a non-QWERTY user-input device as claimed.

3. Regarding claim 2, Fleming disclosed transmitting the user-selected preference data to the electronic system in response to a request as claimed (see column 2, lines 9-13).

4. Regarding claims 3, 5, 14, 20, Fleming disclosed user-selected preference data as telephone directory information as claimed (see column 2, lines 3-5; column 4, lines 35-38).

5. Regarding claims 7 and 13, a wireless connection is inherent through the disclosure of a cellular phone (see column 2, lines 54-64).

Claim Rejections - 35 USC § 103

6. Claims 4, 8, 9, 15-17, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming, III et al. (U.S. Pat. No. 6,625,444), hereinafter referred to as Fleming, and further in view of Brown et al. (U.S. Pat. App. Pub. 2003/0061288), hereinafter referred to as Brown.

7. Fleming disclosed a method and system comprising generating an electronic mail message in response to data entered by a user, the electronic mail message including user-selected preference data for the electronic system (see column 4, lines 17-34; column 4, line 60 through column 5, line 2); transmitting the electronic mail

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message to an electronic mail destination (see column 4, lines 17-34; column 4, line 60 through column 5, line 2); automatically extracting the user-selected preference data from the message (see column 5, lines 2-5); transmitting the user-selected preference data to an electronic system (see column 4, lines 32-49); and configuring the electronic system with the user-selected preference data (see column 4, lines 32-49). Fleming disclosed the use of a cellular phone (see column 2, lines 54-64), thus disclosing the use of a non-QWERTY user-input device as claimed.

8. While Fleming disclosed the use of a cellular phone, Fleming did not specifically disclose the use of a television signal recorder as claimed.

9. In a related art of e-mail communication, Brown disclosed a method and system for providing e-mail message to a client device. The invention of Brown was similar to that of Fleming in that it provided a way to deliver e-mail messages to a client including user-selected preference data for configuring the client system (see paragraph [0011]). Most importantly, Brown disclosed that a client device receiving e-mail messages included a set top box (see paragraph [0020]).

10. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Fleming and Brown to provide a system for generating and transmitting e-mail messages including user-selected preference data to a client device, and configuring the client device according to the user-selected preference data, the client device further including a set top box as claimed. The invention of Fleming sought to provide programming functionality to devices with difficult manual programming capabilities (see column 1, lines 41-67). In other words,

Fleming's disclosed programming system provided greater accessibility to client devices. One of ordinary skill in the art would then be motivated to combine the teachings of Fleming and Brown as Brown similarly sought to provide greater accessibility features to a wide range of client devices (see paragraphs [0009]-[0011]), thus increasing the universality of functions such as e-mail to client devices.

Response to Arguments

11. Applicant's arguments filed 08/21/05 have been fully considered but they are not persuasive.

12. Examiner acknowledges newly submitted drawings filed 08/21/05. Objections to the drawings have been withdrawn.

13. Examiner acknowledges amendments to the Specification in overcoming previous objections. The objections have been withdrawn.

14. Regarding claims 25 and 26 previously rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, the rejections have been withdrawn.

15. Regarding claims 1-3, 5-7, 10-14, 18-20, 25, and 26 rejected under 35 U.S.C. 102(e) as being anticipated by Fleming et al. (U.S. Pat. No. 6,625,444), hereinafter referred to as Fleming, Applicant asserts that the reference does not teach generating "an electronic mail message in response to data entered by a user, the electronic mail message including user-selected preference data for the electronic system" as recited in claim 1. Examiner submits that Fleming undoubtedly disclosed such a feature, where it was disclosed that in response to data entered by a user, the directory assistance

system outputted user preference data via e-mail (see column 3, lines 34-49; column 4, line 60 through column 5, line 6). Such a directory assistance system was disclosed to include a user for entering data (see column 3, lines 35-36, 46). Applicant further asserts that Fleming does not "automatically extract the user-selected preference data from the electronic mail message", but acknowledges that Fleming parses out a telephone number and alphanumeric identifier from an e-mail message transmitted by the directory assistance system (see column 5, lines 2-6). Examiner submits that the parsing of Fleming reads upon the broadly claimed limitation of extracting preference data from the e-mail message. The disclosed parsing of Fleming functions similarly to the claimed extracting, as it isolates the preference data in an e-mail sent by the directory assistance system. Finally, Applicant asserts that Fleming does not teach or suggest "configuring the electronic system with the user-selected preference data", but recognizes that Fleming stores data provided by the directory assistance system. Examiner submits that the storing of Fleming reads upon the broadly claimed limitation of configuring the system, as the information stored in the telephone is programmed into the phone to allow initiation of telephone calls without dialing (see column 4, lines 35-49), thus clearly configuring the phone for a particular operation.

16. Regarding claims 1, 2, 6, 10-12, 18, 19, 25, and 26 rejected under 35 U.S.C. 102(e) as being anticipated by L'Heureux et al. (U.S. Pat. No. 6,697,942), the rejections have been withdrawn.

17. Regarding claims 4, 8, 9, 15-17, and 21-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming, III et al. (U.S. Pat. No. 6,625,444), hereinafter

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referred to as Fleming, and further in view of Brown et al. (U.S. Pat. App. Pub. 2003/0061288), hereinafter referred to as Brown, Applicant asserts that there is no motivation or suggestion to combine the references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brown disclosed ways to provide greater accessibility features to a wide range of client devices (see paragraphs [0009]-[0011]), increasing the universality of functions such as e-mail to client devices, thus motivating one of ordinary skill in the art to incorporate such teachings in the invention of Fleming in order to improve the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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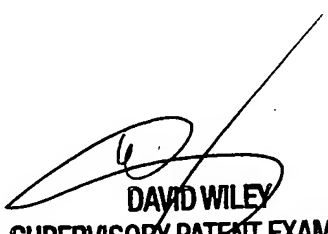
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


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